

Appn. No. 09/998,093
Response A dated August 25, 2003
Reply to Office Action of June 9, 2003

REMARKS/ARGUMENTS

Claim 1 is amended to delete the phrase "the present invention is" from the preamble of Claim 1. Claims 2, 4 and 6 are amended to put the recited list in all three claims into Markush language.

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Arguments 35 USC §112 Rejections

Claims 1-10 are rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants traverse this rejection for the reasons stated hereinafter and respectfully request withdrawal of the rejection.

The Examiner suggested to cancel the phrase "the present invention is" in Claim 1. Claim 1 has been amended to cancel the phrase, and therefore this ground for rejection is obviated.

In Claim 1, line 8, the phrase "in contact with" is vague and indefinite, the Examiner suggests replacing it with a more substantive term, such as e.g., coated with. The term "in contact with" is a definite term. The standard under 35 USC §112, second paragraph, is whether one skilled in the art would be able to determine whether infringement occurs. In the context of Claim 1, the recited element is a heat activatable expandable adhesive in contact with the exterior face of a polymer wall. One skilled in the art would recognize that the recited element, heat activated expandable adhesive, is in contact with at least a portion of the exterior face of the polymer wall. Furthermore, "in contact with" is commonly used in claims wherein an adhesive is an element and located on or adjacent to a substrate. See, the claims of the following U.S. patents: U.S. 6,244,208 (see Claim 1, line 16; Claim 12, lines 15-16 and 22; Claim 14, line 3); U.S. 6,172,698 (see Claim 23, line 6); U.S. 6,586,510 (see Claim 9, lines 8-9; Claim 10, line 17; Claim 14, line 16; Claim 15, line 18; Claim 17, line 18; Claim 18, line 17 and Claim 19, line 14); U.S. 6,176,850 (see Claim 2, line 8; Claim 10, lines 7-8); U.S. 6,171,675 (see Claim 9, lines 7-8); and U.S. 6,168,851 (see Claim 12, line 8). A copy of the front page and claims for each cited patent is enclosed herewith. As the term "in contact with" is commonly used in claims related to contacting an adhesive with a substrate, it is clear that one skilled in the art would understand what is meant by the term, and therefore the term is definite. For this reason, Applicants request that this rejection be withdrawn.

For Claims 2, 6 and 8, the Examiner suggests to rewrite each claim in proper Markush format. In order to advance prosecution, Claims 2, 6 and 8 have been written in Markush format. Applicants respectfully point out that the use of a

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recitation of the elements with the word "or" is equivalent to the Markush language now inserted in the claims. This amendment does not change the scope of the claims or the meaning of the claims, it is simply made to advance prosecution by using an equivalent format which the Examiner is more comfortable with.

35 USC §103 Rejection

Claims 1-10 are rejected under 35 USC §103 (a) as being unpatentable over Thum, U.S. 5,194,199 individually, or in view of Newton, U.S. 3,581,681. Applicants traverse this rejection for the reasons stated hereinafter and respectfully request withdrawal of the rejection.

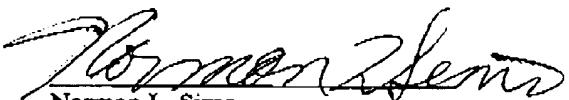
Thum discloses a square shaped insert for improving the structural integrity of a square rail. This insert comprises a foam having an adhesive located thereon to hold the foam part in place in the channel of the rail. The Official Action admits that Thum does not teach the element of a molded shell. The Official Action then draws the conclusion that molded shells are old and well known. To properly make a rejection, all statements of fact should be proven with citation to an appropriate reference or an affidavit of personal knowledge provided by the Examiner. Neither a reference or affidavit of personal knowledge is provided to support the statement made in the Official Action. Furthermore, the fact that molded shells are old and well known is irrelevant in that what is relevant is whether molded shells are known in the art for use with foam structural inserts having an expandable adhesive located on such insert. The Official Action does not contain any evidence that molded shells are known in the context of foam inserts with expandable adhesives located thereon which are useful in improving the structural integrity of a vehicle. Absent a reference which discloses this fact or which clearly motivates one skilled in the art to modify the teachings of the primary reference Thum to include a molded shell as an element, no case of *prima facie* obviousness is made out, and this rejection must be withdrawn.

The Official Action argues in the alternative that Newton suggests modifying the teachings of Thum by including a molded plastic shell. The Newton reference discloses a pallet comprising a thermoplastic outer shell filled with a foam core. The Newton references make no reference to structural reinforcement parts used

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in automobiles. Nor does it teach covering the pallet with an expandable adhesive. Newton is an inappropriate reference to use to provide motivation to modify the teachings of Thum. First, Newton relates to a pallet system and not to structural reinforcing inserts. Furthermore, Newton does not contain any teaching or suggestion that its outer shell be coated with an expandable adhesive. One skilled in the art would not look to the teachings of Newton to modify the teachings of Thum to improve the function of the devices disclosed in Thum. Furthermore, the Examiner has provided no teaching in Thum or Newton or any third reference which would suggests to one skilled in the art that the teachings of Thum and Newton could be read together. In absence of any motivation to read the teachings together, this combination is improper and provides insufficient motivation to modify Thum to achieve the Applicants' invention. In view of the failure of the Official Action to establish a case of *prima facie* obviousness, Applicants respectfully request that this rejection be withdrawn, and Claims 1-10 be allowed under 35 USC §03 and 35 USC §112.

Respectfully submitted,



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